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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,179	08/02/2000	Michael J. McMahon	769-236 Div.	1111

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EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/13/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/631,179

Applicant(s)

MCMAHON ET AL.

Examiner

John Sipos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-33 is/are pending in the application.
- 4a) Of the above claim(s) 9-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The specification is objected to under 37 CFR 1.71 as failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure. (A rejection of claims based on this objection follows this paragraph.) Claim 6, as amended in Amendments of 2/21/2003 and 5/16/2003, can be read either of two ways: (a) the amendments reciting the state of the bag during insertion of the slider or (b) the amendments reciting the positive step of interlocking the closure elements during insertion of the slider. Neither of these cases is clearly supported by the disclosure. In case (a) the whole zipper is not interlocked where the insertion takes place. As stated on page 6, lines 5-15, the slider is preferably inserted at closing end of the zipper, i.e. the zipper being in an interlocked state prior to insertion, but since the insertion of the slider cannot take place without opening the closure elements at least at the point of insertion, it is inaccurate to state that the closure elements are interlocked. In the second case (b), page 6 of the disclosure does not state that a positive step of interlocking the zipper is performed during insertion of the slider. The above quoted lines of the disclosure do state that if the insertion takes place at the open end of the zipper, i.e. the zipper being in an open state, the slider will need to be moved to close the bag.

Claims 6-8 are rejected under **35 U.S.C. ' 112, first paragraph**, as being predicated on an **insufficient disclosure** for the reasons set forth in the objection to the specification set forth above.

The amendments filed 2/21/2003 and 5/16/2003 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the interlocked state of the zipper during application of the slider.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. ' 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 is unclear and inaccurate. It is not clear whether the "interlocking" of the closure elements of the zipper is part of the manipulative steps of the claimed process or is it merely the state of the zipper during the process.

DOUBLE PATENTING REJECTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/915,100. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences are that the claims of the '100 application claims do not recite the insertion of the slider onto the zippers after filling the bags with a product. It would

have been obvious to one skilled in the art to apply the sliders of the claim 6 process of the '100 application after the filling step since the timing of the slider application, i.e. before or after the filling step, would have been merely a matter of obvious design consideration since it doesn't solve any stated problem and the process would perform equally well regardless of the sequence of these steps.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 6-8, to the extent supported by the disclosure, are rejected under 35 U.S.C. ' 103 as being unpatentable over the patent to Herz (3,790,992). The patent to Herz shows a package forming process in which sliders are applied to connected bags that comprise a continuous zipper fastener (see column 3, line 51 et seq.). The process does not discuss the timing of the filling operation. It would have been obvious to one skilled in the art to apply the sliders of Herz after the filling of the bags since the timing of the slider application, i.e. before or after the filling step, would have been merely a matter of obvious design consideration since it doesn't solve any stated problem and the process would perform equally well regardless of the sequence of these steps. Furthermore, slider application to completed packages is well known in the art.

Claims 6-8 are rejected under 35 U.S.C. ' 103 as being unpatentable over the patent to Herz (3,790,992) in view of Machacek (6,047,450) or Richardson (5,442,838) or Herrington (5,067,208) or in the alternative Machacek (6,047,450) or Richardson (5,442,838) or Herrington

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(5,067,208) in view of Herz (3,790,992). The patent to Herz shows the process of applying sliders to connected bags but it does not show the application of sliders to fully interlocked fasteners. The Machacek, Richardson and Herrington patents show the application of sliders to the outside of the fasteners constructed so that the fasteners may be interlocked during application of the sliders. It would have been obvious to one of ordinary skill in the art to either substitute a fastener/slider such as shown by Machacek or Richardson for the fastener/slider of Herz or form the bags of Machacek or Richardson in connected form and apply the sliders to the connected bags as shown by Herz to achieve a more efficient and continuous operation. The timing of the filling operation is not critical and it would have been obvious to one of ordinary skill in the art to fill the bags either before or after the application of the slider.

Claims 6-8 are rejected under 35 U.S.C. ' 103 as being unpatentable over the patent to Herz (3,790,992) in view of Machacek (6,047,450) or Richardson (5,442,838) or Herrington (5,067,208) and further in view of Thomas (5,788,378) or in the alternative Machacek (6,047,450) or Richardson (5,442,838) or Herrington (5,067,208) in view of Herz (3,790,992) and further in view of Thomas (5,788,378). The above references do not show the application of sliders to a filled bag. The patent to Thomas shows a packaging process which comprises forming a bag (see Figures 3-5), filling the bag (see column 6, line 2), sealing the bag (see column 5, line 61 et seq. and Figures 4 and 5), sealing opposing tracks of a zipper to the bag top (see column 2, lines 53-59 and 6, line 3 et seq.) and finally placing a slider over the zipper (column 2, line 60 et seq.). It would have been obvious to one skilled in the art to place the product of the basic references in the bag prior to placing the slider over the zipper as shown by Thomas to avoid contact of the product with the slider.

RESPONSE TO APPLICANT'S ARGUMENTS

Applicant's arguments with respect to the claims have been considered but are not found to be persuasive.

Applicant's main argument is that the sequence of the filling and slider application steps is critical to the process and that the references do not show the step of slider application taking place after the filling step. Although the third rejection made in this action shows this sequence in a packaging process, the Examiner maintains that the application does not set forth that this sequence is critical to the process. In fact, numerous equivalent embodiment are set forth in the disclosure including those wherein the slider application takes place before the filling operation (see Figures 12 and 14-18) or after the filling operation (see Figures 1,5-11).

Applicant further argues that Hertz "never contemplated the filling the bag on a form, fill and seal machine". The claims do not recite a form, fill and seal machine or process. In fact the sealing of the bags is never claimed. The patent to Hertz shows all of the steps of the claimed process with the exception of the slider application taking place after the filling operation.

Regarding the interlocked condition of the fasteners, it is noted that although Hertz does not set forth the interlocked condition of the fasteners it is merely a matter of the specific type of fastener/slider being used that would determine the condition of the fastener at the time of the application of the slider. It is well known in the zipper/slider art to use fasteners which do not require the opening of the fastener during application. These include, two piece sliders that are applied from the outside of the bag, sliders with fold down sides, sliders with separating blades that do not extend down between the profile elements but rather separate the edges of the bag

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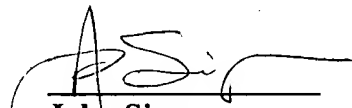
above the profile elements, snap on sliders that are flexed apart during application, etc. Such well-known sliders are used in the second rejection. Note the patent to Herrington specifically states in column 7 line 67 et seq. that the profiles of the fastener are interlocked during application of the slider (also note Figures 2,3,5).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 305-3579**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Peter Vo, can be reached at (703) 308-1789.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.



John Sipos
Primary Examiner
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